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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,054	12/07/1998	AUDREY GODDARD	P1154R2	2403
7590	05/28/2002			
GINGER R DREGER GENENTECH INC 1 DNA WAY SOUTH SAN FRANCISCO, CA 940804990			EXAMINER [redacted]	SPECTOR, LORRAINE
		ART UNIT 1647	PAPER NUMBER 16	
DATE MAILED: 05/28/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.



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EXAMINER
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ART UNIT	PAPER NUMBER
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16

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on 1/8/02
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 25-30, 41-53 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) 25-30, 41-53 are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of Reference Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES--

**Part III: Detailed Office Action**

**Notice:** Effective June 18, 2000, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Lorraine Spector, in Group Art Unit 1647.

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**Restriction Requirement:**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 25-27 and 41-47, as drawn to PRO285, classified in class 530, subclass 387.3.
- II. Claims 25-27 and 41-47, as drawn to PRO286, classified in class 530, subclass 387.3.
- III. Claims 28-30 and 48-50, drawn to antibodies reactive with SEQ ID NO: 1 (PRO285), classified in class 530, subclass 387.9.
- IV. Claims 28-30 and 51-53, drawn to antibodies reactive with SEQ ID NO: 3 (PRO286), classified in class 530, subclass 387.9.

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The inventions are distinct, each from the other because:

Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products appear to constitute patentably distinct inventions for the following reasons:

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PRO285 and PRO286 are different proteins with different primary structures, which require non-coextensive searches. A reference against one would not be a reference against the other. Similarly, the antibodies of Inventions III and IV are different antibodies with different specificities, which require separate searches.

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The polypeptides of Inventions I and II are related to the antibodies of Inventions III and IV, respectively, by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related due to the necessary stearic complementarity of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used another and materially different

process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or in assays for the identification of agonists or antagonists of the protein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

**Advisory Information:**

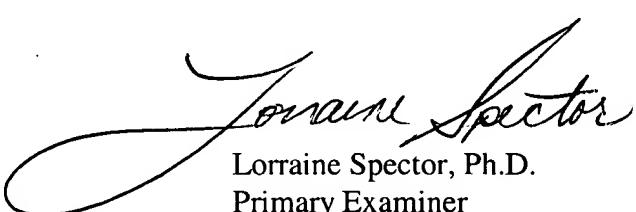
10 Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector, whose telephone number is (703) 308-1793. Dr. Spector can normally be reached Monday through Friday, 9:00 A.M. to 5:30 P.M.

15 If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary L. Kunz, at (703)308-4623.

15 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

20 Certain papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

25 Official papers filed by fax should be directed to (703) 872-9306 (before final rejection) or (703)872-9307 (after final). Faxed draft or informal communications with the examiner should be directed to (703) 746-5228.

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Lorraine Spector, Ph.D.  
Primary Examiner

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5/23/02